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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,532	08/01/2001	Takayuki Yamamoto	Q65685	3507

7590 06/03/2004

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/918,532

Applicant(s)

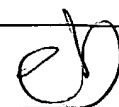
YAMAMOTO ET AL.

Examiner

Tatyana Zalukaeva

Art Unit

1713



--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2,6,7,11 and 12.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Tatyana Zalukaeva
Primary Examiner
Art Unit: 1713

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons set forth in the final rejection and in previous advisory action.

With regard to Applicants' arguments that "weight average molecular weight " as initially appeared in the instant specification was "Inadvertent error with respect to low molecular weight components having molecular weight 100,000..." in addition to above discussed rejection and objection as a new matter, it is also noted that 100,000 is not a low molecular weight.

With regard to indefiniteness rejection of claim 1, in addition to all arguments presented during the prosecution, it is still the Examiner's opinion that the molecular weight limitations of 100,000 or less set forth in claims 4, 5, 9, 10 fails to identify whether this numerical value represents a weight average or a number average molecular weight determination. Therefore, claims 4, 5, 9, 10 do not set out and circumscribe a particular area with a reasonable degree of precision and particularity.

The molecular weight of the compounds cannot be "simply defined as molecular weight" as suggested by Applicants. It should be "weight average"; "number average" or viscosity based molecular weight.

It is imperative that the type of molecular weight be identified, since it is well known that molecular weight of a particular polymer yield significantly different "number average", and "weight average" numerical values. Applicants arguments with regard to how the instant specification supports the amendment to claims are based on semantically different issues, not on showing that the initial component having molecular weight of 100,000 is not a weight average molecular weight.

Furthermore, Applicants may find Ex parte Simpson, 61 USPQ2d 1009 (BdPatApp&Int 2001) of interest. It deals with the issues of Indefiniteness of molecular weight, and an opinion based declaration. The head note reads as follows: Patent examiner's decision to reject applicants' patent claims, directed to blend of linear low density polyethylene and high density polyethylene, for failure to adequately define term "molecular weight" is affirmed, even though applicants submitted

Declaration of inventor indicating that persons of ordinary skill in art would realize that "weight average molecular weight" was intended, since molecular weight can be measured in several different ways, since Manual of Patent Examining Procedure states that factual testimony is preferred over opinion testimony, since inventor's opinion is not supported by adequate documentation in record, and since applicants, therefore, have failed to establish that examiner erred in declining to accord inventor's testimony controlling weight; examiner's finding that inventor's opinion was "self-serving" relates to inventor's interest in outcome of case, which examiner was entitled to factor into analysis, and such finding should not be read as questioning inventor's good faith.

Applicants seek protection for the specific limit of molecular weight, it is imperative that the type of molecular weight be identified, since it is well known that molecular weight of a particular polymer yield significantly different "number average", and "weight average" and/or viscosity average numerical values. This is confirmed very well by the references previously presented by Applicants if read in their entirety. (Stevens, page 412, lines 1-4, and everything starting from third paragraph through page 42), and Billmeyer especially see "hypothetical polymers" on page 19.

Applicants reference to another Patents is not persuasive, because, first of all the Examiner is not bound by other Examiner's decision on patentability, and second, the context wherein the term "molecular weight" is used in cited patents is absolutely different context. Applicants traversal of rejection of the instant claims over Bamba has been addressed in the Final Office Action and is incorporated herein in its entirety.

Applicants are respectfully reminded that the prosecution of the Application is closed.